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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,183	03/15/2002	Yasuyuki Kanada	4325/PCT	8903

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EXAMINER

PETERSON, KENNETH E

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 11/14/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/088,183

Applicant(s)

KANADA ET AL.

Examiner

Kenneth E Peterson

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,8-11 and 13-23 is/are pending in the application.
- 4a) Of the above claim(s) 8-11 and 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,13,14 and 19-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. Applicant's amendment, received 16 October 03, has been entered. Applicant notes that the Examiner discluded claim 13 from examination. Applicant is correct when stating that claim 13 should have been examined. Hereafter is a new, non-final rejection of all active claims.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1,2,13,14,19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of the Kanada patents (EP0940215, US 6,155,755) in view of either Colding (US 3,369,283) or Littecke et al. (US 5,598,621).

Both of the Kanada patents show in figure 4 an indexable insert having all of the recited limitations except that the tool substrate (4) between the sintered bodies (1,1) is only about 25% of the thickness of the rest of the tool substrate, as opposed to the 30%-90% required by most of the claims, or the 32.8%-87.3% required by claim 23.

However, in the art of indexable inserts, both Colding and Littecke show that it is well known to for the portion of the tool substrate between the sintered bodies to be between 32.8%-87.3% of the thickness of the rest of the tool substrate. It would have been obvious to one of ordinary skill in the art to have modified either of the Kanada device by making the portion of the tool substrate between the sintered bodies thicker,

as suggested by both Colding and Littecke, since they are both art recognized equivalents known for the same purpose (see MPEP 2144.06).

4. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with regards to the restriction requirement are still not persuasive. Applicant notes that patent 6,155,755 has both apparatus claims and method-of-making claims. The key difference between this patent and the current application is that the apparatus-product claim in the patent is obviously allowable, thus necessitating that the method-of-making claims be joined therewith. In the current case, the apparatus-product claims are not allowable, thus MPEP 821.04 and 2116.01 do not apply. However, if an allowable apparatus-product claim is eventually agreed to, the Examiner will be happy to rejoin the method-of-making claims, so long as it is clear that it includes all of the limitations of the allowable product.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth Peterson whose telephone number is 703-308-2186. The examiner can normally be reached on Monday-Thursday, 7:30-4:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached at 703-308-1082.

All responses are encouraged to be by fax at 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

kp  
November 6, 2003

  
KENNETH E. PETERSON  
PRIMARY EXAMINER